

**Notice of Allowability**

Application No.

10/524,268

Examiner

Paul A. Zucker

Applicant(s)

ADAMI ET AL.

Art Unit

1621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_.
2. ☒ The allowed claim(s) is/are 1-8 and 16-20 renumbered 1-13, respectively.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date 2/11/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 20070621
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_.

PAULA ZUCKER, PH.D.  
PRIMARY EXAMINER

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8 and 16-20, drawn to a process for preparing acid formates.

Group II, claim(s) 9-11, drawn to an apparatus for the preparation of acid formates.

Group III claim(s) 12-15, drawn to a method for using acid formates.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The only possible special technical feature which could form the link between I and III is the acid formate itself. The acid formate itself is known (See reference CD on IDS filed 11 February, 2005, to Kendall) and cannot therefore provide the required special technical feature for unity of invention. Groups II-III again can be linked only by the acid formate itself. Groups I-II correspond to a process and an apparatus adapted especially for that process. The claimed apparatus, however, is indistinguishable

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from a plethora of similar arrangements in the literature in which a reactor is connected to a series of three distillation columns and therefore does not appear to be specially adapted to the claimed process.

1. During a telephone conversation with Matthew J. Mason on 22 May 2007 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8 and 16-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Allowable Subject Matter***

2. The following is an examiner's statement of reasons for allowance: The instantly claimed process for the preparation of acid formates is neither disclosed nor fairly suggested by the prior art of record. The prior art neither discloses nor fairly suggests the preparation of acid formates by the combination of formic acid and formate streams formed, respectively, by the sequential hydrolysis of methyl formate under both neutral and basic conditions.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **EXAMINER'S AMENDMENT**

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Matthew J. Mason on June 21, 2007.

The claims have been amended as follows:

Claims 9-15 have been canceled.

The specification has been amended as follows:

On page 3 of the specification, prior to the paragraph beginning at line 18, the following has been added:

#### **--BRIEF DESCRIPTION OF THE DRAWINGS**

FIG. 1 shows a representative schematic of a process flow chart illustrating a first preferred embodiment of the invention; and

FIG. 2 shows a representative schematic of a process flow chart illustrating a second preferred embodiment of the invention.

#### **DETAILED DESCRIPTION OF EMBODIMENTS OF THE INVENTION--.**

***Conclusion***

4. All questions pertaining to an application that has been allowed should be directed to the Office of Patent Publications Image Assistance Center at 888-786-0101.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
PAULA A. ZUCKER, PH.D.  
PRIMARY EXAMINER

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